

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte JACQUES JOLLY,
REMI FAUCHE and JEAN-FLORENG CAMPION

Appeal No. 2003-0607
Application No. 09/532,968

HEARD: June 11, 2003

Before PAK, OWENS, and POTEATE, **Administrative Patent Judges**.

POTEATE, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1-8. Claims 9-17 are also pending but have been withdrawn from consideration as being

directed to a non-elected invention.¹ See Final Rejection, Paper No. 7, mailed March 21, 2002, page 2 (citing 37 CFR § 1.142(b)).

Claim 1 is representative of the subject matter on appeal and is reproduced below:

1. A method of building up an optical fiber preform in an installation provided with means enabling a preform held horizontally at ends of the preform between two mounting points by supporting the ends of the preform with end pieces for rotation about an axis of the preform and for relative movement in a direction parallel to the axis of the preform said installation also being provided with heater means for heating the preform by means of a plasma torch, which heater means is disposed radially relative to said preform and is associated with material supply means, so as to enable the preform to be manufactured in successive passes corresponding to the preform and the torch being displaced relative to each other, certain ones of the passes carried out with material being supplied and certain other ones of the passes being carried out without material being supplied, so that each successive pass leads to a new layer of material being deposited on the preform when material is supplied and to the most recent layer deposited being glazed when material is not supplied, said method interposing a one-ended reduction in the length of at least one layer, during a pass and starting from one new layer that is an intermediate layer, while a succession of concentric layers of material are being deposited on the preform in a manner such that the

¹Appellants have requested that the Board also review claims 9-17. See Appeal Brief, Paper No. 11, received August 21, 2002, page 2. Appellants are reminded that any request for reconsideration from a requirement for restriction made final by the examiner must be made by petition to the Commissioner. "Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181)." 37 CFR § 1.144 (July 1, 2002).

respective lengths of the layers, which lengths are determined by the relative displacements between the torch and the preform, are progressively shortened as a result of a progressive reduction in the lengths of the displacements, so that the thickness of deposited material that covers the preform and a portion of each of the end-pieces decreases uniformly towards the ends, said one-ended reduction in layer length leading to a limitation of the thickness of material deposited on one of the end-pieces and on a limited-length preform zone that is longitudinally adjacent to said end-piece, at the level set by the layer deposited immediately prior to said one-ended reduction, and

wherein the one ended reduction in the length is greater than a reduction in length of an immediately prior layer from a second to the immediate prior layer.

The examiner has indicated that the claims are allowable over the prior art of record, "because the prior art does not teach reducing layers such that prior layers have a smaller reduction in length" as required by the claims. See Final Rejection, page 4.

GROUNDS OF REJECTION

Claims 1-8 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor[s], at the time the application was filed, had possession of the claimed invention.

We reverse.

DISCUSSION

The invention relates to a method of manufacturing or building up ["overcladding"] an optical fiber preform. See Appeal Brief, page 3. In particular, appellants' method provides an improvement on that portion of the overcladding process relating to the zone wherein the preform is to be separated from its supporting end pieces. See *id.* According to appellants' invention, "fewer concentric layers of silica [are] deposited on the preform in the zone where the preform is to be separated. As a result, the preform has a reduced diameter portion defining a step near one end of the preform." *Id.* (citations omitted). Appellants assert that the claim language relating to this feature of the invention is the following:

said method interposing a one-ended reduction in the length of at least one layer, during a pass and starting from one new layer that is an intermediate layer, said one-ended reduction in layer length leading to a limitation of the thickness of material deposited on one of the end-pieces and on a limited-length preform zone that is longitudinally adjacent to said end-piece, at the level set by the layer deposited immediately prior to said one-ended reduction, and

wherein the one-ended reduction in the length is greater than a reduction in length of an immediate prior layer from a second to the immediate prior layer.

Appeal Brief, pages 3-4. Appellants state that the above underlined portion was added by amendment "to clarify what was already implicitly, if not explicitly, recited by the claim." *Id.*, page 4.

According to the examiner, there is no support in the specification for the above underlined language. See Examiner's Answer, Paper No. 12, mailed September 23, 2002, page 4. In particular, it is the examiner's position that he was unable to find either explicit or implicit support for this claim limitation and, further, that the drawings suggest the opposite of this limitation, i.e., that the reduction is less, not greater. *Id.*, page 4. Accordingly, the examiner maintains that the rejection of claims 1-8 under 35 U.S.C. § 112, first paragraph, as appropriate.

The test for determining compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the later claimed subject matter at the time of the

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invention, rather than the presence or absence of literal support in the specification for the claim language. **See Vas-Cath, Inc.**

v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and **In re Kaslow**, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). As explained by the Court in **Vas-Cath**, 935 F.2d at 1563-64, 19 USPQ2d at 1117:

35 U.S.C. 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use": the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession **of the invention**. The invention is, for purposes of the "written description" inquiry, **whatever is now claimed**.

. . . drawings alone **may** be sufficient to provide the "written description of the invention" required by § 112, first paragraph.

The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the appellants' disclosure a description of the invention defined by the claims. **See In re Wertheim**, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976); **Ex parte Sorenson**, 3 USPQ2d 1462, 1463 (Bd. Pat.

App. & Int. 1987). In the present case, we conclude that the examiner has failed to meet this initial burden.

The examiner asserts that he could find neither explicit nor implicit support for the claim language at issue. However, we are in agreement with appellants that the language found on page 8, lines 3-10, of the specification (Appeal Brief, page 4) as well as the description provided on page 8, line 10-page 9, line 2, reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. In fact, the phrase "one-ended reduction in layer length" used in the disputed claim language appears on page 8, line 3, of the specification, and the meaning of this phrase is described in connection with figure 2. See specification, page 9, line 2, referencing figure 2, as well as the reference numerals D1, 10' and L1 all of which are used in discussing the "one-ended reduction in layer length" and appear only in figure 2. Thus, we cannot agree with the examiner that one of ordinary skill in the art would somehow interpret the language "one-ended reduction in the length" as relating to the process steps involved in cleaving the preform which are

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discussed in connection with figure 3 (see Examiner's Answer, page 4, last paragraph). See Specification, page 9, line 24-page 10, line 12, which describes the cleaving process.

Accordingly, we find that the examiner has failed to establish a **prima facie** showing of lack of support under 35 U.S.C. § 112, first paragraph, and the rejection of claims 1-8 is reversed.

REVERSED

Chung K. Pak
CHUNG K. PAK)
Administrative Patent Judge)
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)
Terry J. Owens) BOARD OF PATENT
TERRY J. OWENS) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
Linda R. Poteate)
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